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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,626	07/13/2001	Changguan Fan	42390P12061	3702

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TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER

SHIN, KYUNG H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,626

Applicant(s)

FAN ET AL.

Examiner

Kyung H Shin

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responding to application papers dated 7/13/2001
2. Claims 1-7 are pending. Independent claims are **1, 4, and 6.**

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2, 4, 6, 7** are rejected under 35 U.S.C. 102(e) as being unpatentable over **O'Toole et al.** (US Patent No. 6,345,294: Methods and apparatus for remote configuration of an appliance on a network, Filed on Apr. 19, 1999).

Regarding Claim 1, O'Toole discloses a method of a server system custom provisioning a generically pre-provisioned client device (see col. 3, lines 37-39: device configuration equivalent to provisioning: The Applicant's specifications at paragraph [0006], lines 6-8 state that "the terms "configure" and "provision" will be used somewhat interchangeably."), the method comprising:

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receiving a connection from the client device; (see col. 6, lines 35-44: appliance connects to server) and

downloading provisioning data to the generically pre-provisioned client device.

(see col. 3, lines 41-44: download additional configuration information)

Regarding Claim 2, 7, O'Toole discloses the method, instructions of claim 1, 6 further comprising:

authenticating the generically pre-provisioned client device and the downloading being conditioned upon the authenticating. (see col. 15, lines 48-53; authentication information required before access)

Regarding Claim 4, O'Toole discloses a system comprising:

a network; (see col. 6, lines 54-55: LAN with access to the Internet)

a server system coupled to the network and including,

a provisioning server, (see col. 6, lines 29-35: appliance registry server)

a provisioning database having stored therein provisioning data for at least one generically pre-provisioned client device; (see col. 7, lines 16-28: registry attached database) and

a generically pre-provisioned client device coupled to the server system via the network. (see col. 6, lines 28-35: pre-configured client (reference's appliance) connects to server)

Regarding Claim 6, O'Toole discloses an article of manufacture comprising:

a machine-accessible medium including instructions that, when executed by a machine, cause the machine to perform the method of claim 1. (see col. 6, lines 35-44: appliance connects to server; see col. 3, lines 41-44: download additional configuration information)

Claim Rejection 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3, 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole et al. (US Patent No. 6,345,294) in view of **Ylonen** (US Patent No. 6,782,474: Network connectable device and method for its installation and configuration).

O'Toole discloses an apparatus that provides a pre-configured network connected appliance that is capable of obtaining its final configuration information from network server. (see O'Toole col. 2, line 66 - col. 3, line 1: "... *invention provides a network appliance...capable of remote booting and...obtaining its configuration information from a source....*")

Regarding Claim 3, O'Toole does not specifically disclose an out-of-band method such as e-mail, phone call, or any other non-network method for the receipt of authentication information. However, Ylonen discloses the method of claim 2 further comprising:

sending out-of-band data to a user of the generically pre-provisioned client device prior to receiving the connection. (see col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Toole to obtain authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to modify O'Toole in order to remotely configure a network connected appliance that obtains its final configuration information from a network server. (see Ylonen col. 2, line 67 - col. 3, line 7: *"...where security is an issue, it is desirable to be able to configure new network devices remotely and securely from a remote network management station..."*)

Regarding Claim 5, O'Toole discloses the system of claim 4 wherein the generically pre-provisioned client device comprises:

generically pre-provisioned data which have been provisioned prior to an initial connection of the generically pre-provisioned client device to the server system via the network; (see col. 6, lines 28-35: appliance has pre-configured information) and

provisioning data which have been provisioned by the provisioning server after an initial connection of the generically pre-provisioned client device to the server system via the network. (see col. 3, lines 34-39: configuration data transmitted to client device (reference's appliance))

O'Toole does not specifically disclose an out-of-band method such as e-mail, phone call, or any other non-network method for the receipt of authentication information. However, Ylonen discloses the system of claim 4 wherein the generically pre-provisioned client device comprises:

out-of-band data which have been stored into the generically pre-provisioned client device by a user; (see col. 7, lines 56-61; col. 9, lines 15-23: receive authentication information via out-of-band method)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Toole to obtain authentication information via an out-of-band method as taught by Ylonen. One of ordinary skill in the art would be motivated to modify O'Toole in order to remotely configure a network connected appliance that obtains its final configuration information from a network server. (see Ylonen col. 2, line 67 - col. 3, line 7: *"...where security is an issue, it is desirable to be able to configure new network devices remotely and securely from a remote network management station..."*)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H Shin whose telephone number is 703-305-0711. The examiner can normally be reached on 9 am - 7 pm.

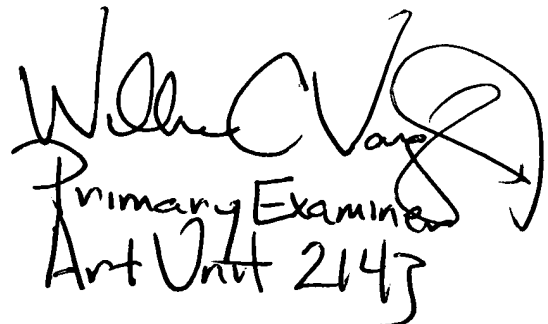
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KHS

Kyung H Shin
Patent Examiner
Art Unit 2143

KHS
Oct. 14, 2004


Primary Examiner
Art Unit 2143